



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,274	03/09/2000	Regis Nicolas	PALM-3024.IPG.US.P	2735

7590 05/19/2003
Wagner Murabito & Hao LLP
Two North Market Street
Third Floor
San Jose, CA 95113

EXAMINER

SAID, MANSOUR M

ART UNIT	PAPER NUMBER
----------	--------------

2673

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,274

Applicant(s)

NICOLAS ET AL.

Examiner

MANSOUR M SAID

Art Unit

2673



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-11 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11 and 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This office action is in respond to the amendment filed on February 25, 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. **Claims 1, 4-5, 7, 9-10, 14-15, 17-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani (5,483,262) in view of Snell (5,756,941) as applied to claims 1, 10 and 18, and further in view of Schrock et al. (5,845,161; hereinafter referred to as Schrock).**

As to claims 1, 7, 10, 17-19, and 23, Izutani teaches a computer system (figure 1, (10)) comprising a processor (figure 1, (11)) coupled to bus; a memory unit (figure 1, (13-14)) coupled to the bus; a display screen (figure 1, (15)) coupled to the bus; a case (unit, (figure 1, (17) for supporting the processor, the memory unit, and the display screen, the case (figure 2a, (17)) having a slot (pen holder, (figure 2a, (2)) located therein for receiving a stylus (pen, (figure 2a, (1)); a detector (pen detecting circuit) for detecting the stylus in the slot , a switch coupled to the detector for generating a signal to power up the processor, the display screen (figure 9) (column

Art Unit: 2673

1, lines 11-22), into a power conservation mode when the stylus is inserted into the slot (figures 1, 2a-2c, 3a-3d, 4, and 5); (abstract; column 1, lines 45-67; column 2, lines 1-67; column 3, lines 1-53; column 4, lines 1-35; and column 5, line 17 through column 6, line 60).

Izutani does not expressly teach wherein a stylus having a digitizer housing, and wherein the slot (comprises a longitudinal opening for receiving the stylus.

However, Snell (figures 1-5) teaches a stylus with a digitizer housing (abstract; column 3, line 50 through column 4, line 67), and wherein the slot (pen storage chamber, (110)) comprises a longitudinal (vertically and accessed from the top edge of the hand-held) opening for receiving the stylus (figures 1-5, (column 3, lines 50-67 and column 4, lines 1-13), and wherein the slot comprises a longitudinal opening for receiving the stylus (figures 1-5).

Therefore, it would have obvious to one ordinary skill in the art at the time the invention was made to incorporate Snell's digitizer pen having digitizer housing into Izutani's handheld device so as to provide input to the hand-held computer so that visual feedback can be displayed for the user on the display (column 4, lines 30-35).

Izutani and Snell do not teach non-mechanically detector for detecting the stylus in the slot.

However, Schrock (figures 1-9) teaches a stylus comprising a touch screen and non-mechanically detector for detecting the stylus in the slot (abstract; column 2, lines 1-65; column 3, lines 1-5; column 3, lines 45-65; and column 4, lines 1-67 .

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Schrock's teaching detecting the stylus into Izutani's modified system so to effect a mode change (column 2, lines 10-11).

As to claims 4, 14, and 20, Izutani (figures 8a-8b) teaches wherein the detector is located within the slot and is an electrical detector (column 3, lines 1-62; column 4, lines 1-35); and (column 5, lines 1-10).

As to claims 5, 15, and 21, Izutani (figures 2a-2c) teaches wherein the computer system is a palmtop computer system (information processor, (10)), (abstract; column 2, lines 55-67; and (column 3, lines 1-62).

As to claim 9, Snell (figure 1) teaches wherein the digitizer (108) is separate in area from the display (106) column 3, lines (50-67).

3. Claims 3, 6, 11, 13, 16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani and Snell in view of Schrock as applied to claims 1, 10, and 18 above, and further in view of Ogawa (6,100,538).

Izutani, Snell, and Schrock teach all claimed limitations in claims 3, 6, 11 and 13 except that optical detector and a battery which is supplying power to the computer.

However, Ogawa (figures 1-2) teaches an optical digitizer and display panel (6), a stylus (2) for an inputting device or pointer. Stylus that projects light directly or indirectly on a coordinate plane (1), the digitizer is provided with detector means units (3L and 3R) arranged around the coordinate plane (1) (column 6, lines 40-67), and also optical detector and a battery which is supplying power to the computer (abstract; column 2, lines 40-67; column 3, lines 40-56; column 4, lines 1-10; column 5, lines 19-30; column 9, lines 22-50; column 12, lines 30-62; and column 13, lines 1-25).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Ogawa's optical digitizer device having optical detector and battery into Izutani's modified device so as to provide an optical digitizer capable of operating with stability with out being affected by extraneous light including light radiated from the display panel of the digitizer (column 2, lines 40-46).

4. Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Izutani, Snell in view of Schrock as applied to claims 1 and 18 above, and further in view of Dao et al. (5,049,862; hereinafter referred to Dao).

Izutani, Snell and Schrock disclose all claimed limitations in claims 8 and 24 except that a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters.

However, Dao teaches (figure 1) a notebook (10) includes a first panel, a second panel (14) connected to first panel (12) by a hinge means (16) that allows both first and second panel to orient in a multitude of angles about hinge means, and a stylus (18) for writing on first panel and second panel. First panel (12) has flat surface (20) with an opaque first digitizer tablet (22) and allows placement of standard templates (column 3, line 60 through column 4, line 14); and a first region for capturing stroke data associated with alphabetic characters and a second region for capturing stroke data associated with numeric characters (figure 8, column 7, line 42 through column 8, line 3).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to combine Dao's portable computer having alphabetic and numeric

character into Izutani's modified device to allow real-time coupling of manual paper form completion into machine recognizable form (column 1, lines 1-10).

Response to Arguments

5. Applicant's arguments filed 2/25/03 have been fully considered but they are not persuasive.

Applicant (on pages 5-7) argued that "Izutani does not teach or suggest Izutani does not expressly teach wherein a stylus having a digitizer housing, and wherein the slot comprises a longitudinal opening for receiving the stylus.

However, Examiner respectfully disagrees for the following reasons, Snell has been used for such claimed limitations (figures 1-5) teaches a stylus with a digitizer housing (abstract; column 3, line 50 through column 4, line 67), and wherein the slot (pen storage chamber, (110)) comprises a longitudinal (vertically and accessed from the top edge of the hand-held) opening for receiving the stylus (figures 1-5, (column 3, lines 50-67 and column 4, lines 1-13).

Therefore, it would have been obvious to one ordinary skill to use Izutani's teaching to increase the versatility of the device.

Applicant (on page 9) argued that "nowhere does the combination of Izutani, Snell and Schrock teach or suggest a hinge and a protective cover".

However, Examiner again respectfully disagrees, such claimed limitations "power conservation mode" fairly reads as power off mode which is clearly stated by Izutani (figures 3a-3d, 4-5 and 9; abstract, column 2, lines 5-67; column 3, lines 1-55 and column 4, lines 29-53).

The combination of all references fairly disclose the claimed limitations, therefore, all references should be taken in combination and not individually. **The Applicant can not show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. In re keller, 208 USPZ 871 (CCPA 1981).**

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Uchida (5,067,573) discloses an electronic tablet which receives handwritten input via an input pen, including a receptacle for the pen and a detector operative to detect the presence of the pen in the receptacle.

Makinwa et al. (5,750,939) disclose a stylus that has a detector whereby a disturbance of the field.

Chmaytelli (6,233,464) discloses a power on/off in combined PDA /Telephone.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **OFFICE THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mansour M. Said** whose telephone number is **(703) 306-5411**.

The examiner can normally be reached on Monday through Thursday from 8:30 a.m. to 6:00 p.m. The examiner can also be reached on alternate Friday from 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Shalwala Bipin**, can be reached at **(703) 305-4938**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer service Office

Application/Control Number: 09/522,274
Art Unit: 2673

Page 9

whose telephone number is (703) 306-0377.

Patent Examiner

May 12, 2003

Mansour M. Said

A handwritten signature in black ink, appearing to read "Bipin Shalwala", written in a cursive style.

BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600